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FACSIMILE COVER SHEET

DATE: MAY 26, 2005

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THIS TRANSMITTAL COVER SHEET): 6

OUR REFERENCE: 224488

FROM: XAVIER PILLAI
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TO: EXAMINER CAROL M. KOSLOW
ART UNIT 1755
UNITED STATES PATENT AND TRADEMARK OFFICE
ALEXANDRIA, VIRGINIA 22313-1450

FACSIMILE NUMBER: 703/872-9306

REPLY TO OFFICE ACTION

IN RE APPLN. OF: KOZEE ET AL.
APPLICATION NO. 10/800,426
FILING DATE: MARCH 12, 2004
TITLE: INK JET INK COMPOSITION AND METHOD FOR SECURITY
MARKING
EXAMINER: CAROL M. KOSLOW
ART UNIT: 1755
ENCLOSURES: FORM PTO-1083 (1 PG. IN DUPLICATE); RESPONSE TO OFFICE ACTION
(3 PGS.); AND FAX COVERSHEET (1 PG.)

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In re Application of: KOZEE et al.
Application No. 10/800,428
Filed: March 12, 2004
For: INK JET INK COMPOSITION AND METHOD FOR SECURITY MARKING

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

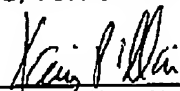
Transmitted herewith is a reply to office action in the subject application.

- ☐ Small entity status is claimed for this application under 37 CFR 1.27.
- ☒ Petition for an extension of time for the period noted below, as well as for any additional period necessary to render the present submission timely. Please charge Deposit Account No. 12-1216 for the appropriate petition fee.
- ☐ Other:
- ☒ Please charge Deposit Account No. 12-1216 in the total amount indicated below. A duplicate copy of this transmittal sheet is enclosed herewith.

					SMALL ENTITY		OTHER THAN A SMALL ENTITY	
TIME EXTENSION PETITION FEE			none		\$ 0.00		\$ 0.00	
	subtract time extension fee previously paid		none		(\$ 0.00)		(\$ 0.00)	
CLAIM FEE	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	EXTRA CLAIMS PRESENT	RATE	ADD'L CLAIM FEE	RATE	ADD'L CLAIM FEE
TOTAL	157	MINUS	157	= 0	x 25=	\$	x 50=	\$0.00
INDEPENDENT	5	MINUS	5	= 0	x 100=	\$	x 200=	\$0.00
<input type="checkbox"/>	FIRST PRESENTATION OF MULTIPLE CLAIM				+ 180=	\$	+ 360=	\$
TOTAL AMOUNT TO BE CHARGED TO DEPOSIT ACCOUNT					TOTAL	\$	TOTAL	\$0.00

- ☒ The Commissioner is hereby authorized to charge any deficiencies in the following fees associated with this communication or credit any overpayment to Deposit Account No. 12-1216.
- ☒ Any filing fees under 37 CFR 1.16 for the presentation of extra claims.
- ☒ Any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,
LEYDIG, VOIT & MAYER, LTD.

By 
Xavier Pillai, Reg. No. 39,799

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Amendment or ROA Transmittal (Revised 5/9/05)

In re Application of: KOZEE et al.
Application No. 10/800,426
Filed: March 12, 2004
For: INK JET INK COMPOSITION AND METHOD FOR SECURITY MARKING

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a reply to office action in the subject application.

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CLAIM FEE	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	EXTRA CLAIMS PRESENT	RATE	ADD'L CLAIM FEE	RATE	ADD'L CLAIM FEE
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<input type="checkbox"/>	FIRST PRESENTATION OF MULTIPLE CLAIM				+ 180=	\$	+ 360=	\$
TOTAL AMOUNT TO BE CHARGED TO DEPOSIT ACCOUNT					TOTAL	\$	TOTAL	\$0.00

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Respectfully submitted,
LEYDIG, VOIT & MAYER, LTD.

By 

Xavier Pillai, Reg. No. 39,799

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Amendment or ROA Transmittal (Revised 5/9/05)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 10/800,426

Applicants: KOZEE et al.

Filed: March 12, 2004

TC/AU: 1755

Examiner: KOSLOW, Carol M.

Docket No.: 224488 (Client Reference No. D-676)

Customer No.: 23460

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

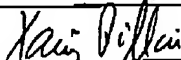
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MAY 26 2005

REPLY TO OFFICE ACTION

Sir:

In reply to the Office Action dated April 26, 2005, please consider the following.

MAILING/TRANSMISSION CERTIFICATE UNDER 37 CFR 1.8 OR 1.10			
I hereby certify that this document and all accompanying documents are, on the date indicated below, being <input type="checkbox"/> deposited with the U.S. Postal Service using "Express Mail" service in an envelope addressed in the same manner indicated on this document with Express Mail Label Number <input type="checkbox"/> deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed in the same manner indicated on this document, or <input checked="" type="checkbox"/> facsimile transmitted to the U.S. Patent and Trademark Office at fax number: 703/872-9306.			
Name (Print/Type)	Xavier Pillai		
Signature		Date	May 26, 2005

Application No. 10/800,426

Reply to Office Action

The Office Action states that claim 2 is generic to a plurality of disclosed patentably distinct species comprising a luminescent colorant and a non-luminescent colorant. The Office Action requires the Applicants to elect a single disclosed species. Applicants provisionally elect the species luminescent colorant. Applicants respectfully traverse the species election requirement. Reconsideration is requested in view of the following.

An application can claim more than one distinct species, not to exceed a reasonable number, so long as the application also includes an allowable generic claim embracing the distinct species. 37 C.F.R. §1.141(a). Applicants respectfully submit that the generic claim 2 does not include an unreasonable number of species and that a search in examination of all the species in one application would not impose a serious burden on the Examiner. The Office Action indicates that there are two distinctive species. Applicants respectfully submit that the identified number (two) does not exceed a reasonable number. In addition, Applicants have provided at least one generic claim encompassing the distinct species. In view of the foregoing, Applicants respectfully submit that the species election requirement is erroneous and should be withdrawn.

The Office Action further requires Applicants to restrict to one of three groups of claims if a luminescent colorant species is elected. Applicants respectfully traverse this restriction requirement. Applicants respectfully submit that there would be no serious burden in examining all three groups of claims together in one application, e.g., the search results between groups I and II are likely to overlap. Moreover, groups II and III are classified in the same class and subclass (427/8). Applicants respectfully request reconsideration.

Applicants provisionally elect group I: claims 1-3, 5-113, 117, 118, 120, and 122-157 for further prosecution. Claims 3, 43-45, 75, and 122-130 read on the elected species. Claims 1, 2, 5-42, 46-74, 104-121, and 131-157 are generic.

As discussed, the species election requirement is erroneous. Accordingly, if the species election requirement is withdrawn, then the restriction requirement becomes moot. In that event, Applicants respectfully submit that all groups of claims (groups I-III of the luminescent colorant and groups I, I', II, and III of non-luminescent colorant) should be examined together. Further, group I (luminescent) and group I (non-luminescent) are in the same class and subclass (252/301.16). Groups II-III (luminescent) and groups II-III (non-luminescent) are in the same class and subclass (427/8). As such, there exists much commonality of class and subclass among the groups of claims. Furthermore, the search

Application No. 10/800,426

Reply to Office Action

results are likely to overlap. Accordingly, Applicants respectfully submit that there will not be a serious burden on the Examiner to consider all the claims together.

A favorable decision is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of this application, she is requested to call the undersigned attorney.

Respectfully submitted,



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Date: May 26, 2005